

REMARKS

An Office Action was mailed on June 12, 2003. Claims 1-18 are pending in the present application.

Applicant is submitting herewith a Change of Correspondence form. All future correspondence in this matter should be directed to Customer Number 026304. The attorney docket number has also changed to 3251/FBR (031035-87578), and it is respectfully requested that the Examiner update such information in the PALM system.

Claim 10 is objected to because the term "define" should be -- defines --. Responsive thereto, Applicant has amended claim 10 as suggested by the Examiner. Accordingly, it is respectfully requested that the Examiner withdraw his objection to the claims.

Claims 1-18 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Responsive thereto, Applicant has amended the claims to overcome the §112 rejections. Such claim amendments are believed to be self-evident and not worth explaining in detail. Accordingly, it is respectfully requested that the Examiner withdraw the rejection under 35 U.S.C. § 112, second paragraph.

Claims 1-4, 6-8 and 12 are rejected under 35 U.S.C. §102(e) as being anticipated by O'Halloran (U.S. Patent 6,450,883), while claims 5, 9, 10 and 14-17 are rejected under 35 U.S.C. §103(a) as being unpatentable over O'Halloran '883 in view of Baerlocher et al. (U.S. patent 5,788,573). Claims 10, 11 and 13 are further rejected under 35 U.S.C. §103(a) as being unpatentable over O'Halloran '883 in view of DeMar et al. (U.S. Patent 6,315,660), while claim 18 is rejected under 35 U.S.C. §103(a) as being unpatentable over O'Halloran '883 in view of Baerlocher et al. '573 in further view of DeMar et al. '660.

The subject application is directed to a gaming machine in which on the occurrence of a predefined triggering event, the player is offered a choice of two or more different prize sets which may for example, be displayed on two or more simulations of spinning wheels. Each prize set contains a plurality of prize outcomes. The player chooses one of the wheels/prize sets and a prize is awarded to the player from that prize set by a random process. The prize sets

generally include a set offering a good probability of winning one of a number of relatively small prizes and a set offering a relatively large prize but with reduced chances of winning.

O'Halloran '883 discloses a gaming machine playing an underlying or base game. On the occurrence of a predefined triggering event, a bonus game is entered in which three rows of respectively 2, 3 and 4 playing cards are arranged face down. A player is required to select one of the rows and choose one card from that row. If a JOKER is revealed, the player's existing win is multiplied by 2x, 3x or 4x depending on the row selected. As there is only one joker in each row, the odds of winning depend on the number of cards in each row.

Baerlocher et al. '573 discloses a gaming machine playing a base game and having a feature game in which three "wheels of fortune" are displayed. However, although the three wheel indicia are shown simultaneously on the screen, the player does not select a wheel, from a choice of three wheels and choose which one to play. Instead, they are spun in a hierarchical fashion, such that at least a first predetermined result must be achieved on a first wheel in order for the user to be permitted to obtain a simulated spin of the second reel and so on. With reference to column 9, lines 12-28, the odds of winning on each of the wheels are somewhat different with the first wheel providing a one in twenty chance of the player having an opportunity to spin the second wheel, the second wheel providing a one in forty chance of spinning the third wheel and the third wheel providing a one in two hundred chance of winning a jackpot.

Thus, although Baerlocher does disclose a secondary game in which a number of different wheels having different chances of winning are displayed, it teaches that they are played sequentially and does not offer the player a choice of selecting which wheel to play.

DeMar et al. '660 discloses a gaming machine including a "monopoly" bonus mode including a bonus random roll of dice which determines the distance traveled on the board. In DeMar et al., the roll of the die only determines the number of places a token will move in the game and the dice does not actually display the prize outcomes.

The claims of the present invention have been amended in order to more clearly distinguish over O'Halloran '883 as follows.

In O'Halloran, the prize outcome depends on, i.e. is a multiple of, the prize won in the underling base game. Specifically, the prize outcome is either twice, 3x or 4x the prize won in the base game. In the present invention as recited in the revised claims 1, 14 and 17, the prize outcomes in the prize sets are independent of the prize won in the base game which constitutes the predefined triggering event. Indeed, in the subject patent application, the predefined triggering event may not even result in the payment of a prize to a player, it may only trigger the feature game and if no prize is won on the feature game, then no prize will be won on that play of the game. Note, also that in the present invention, in contrast with O'Halloran, a non-winning outcome on the feature game does not result in the loss of any prize won of the base game that result in the predefined triggering event. The prizes won on the feature game and the underlying game are totally independent. O'Halloran is essentially concerned with multiplying a win on a base game. In the present invention, the base game only provides a trigger and the outcome is independent of the prize result in the base game.

There is a second key distinguishing feature which is recited in amended claims 1 and 14 and that is that at least one of the prize sets defines two or more winning outcomes. (Note that this feature is not recited in claim 17, although that claim does recite that the prize outcomes are independent of any prize awarded in the underlying game).

In O'Halloran '883, each prize set contains only one JOKER and therefore, only one potential winning outcome. In the present invention, by providing a plurality of winning outcomes in at least one of the prize sets, the level of interest and sophistication of the secondary game is considerably increased compared with O'Halloran which essentially offers a minor variation on the basic "double or nothing red card or black card" gamble traditionally provided on gaming machines playing poker games.

Accordingly, Applicant respectfully submits that the amended claims are not taught or reasonably suggested by the cited art. The Manual For Patenting Examining Procedure (MPEP) § 2131 clearly sets forth the standard for rejecting a claim under 35 U.S.C. § 102(b). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (MPEP § 2131, quoting Verdegaal Bros. v. Union Oil Co. of California 2 USPQ2d 1051, 1053 (Fed Cir. 1987)). "The identical invention

must be shown in as complete detail as is contained in the ...claim." (MPEP § 2131, quoting Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). "The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e. identity of terminology is not required." (MPEP § 2131, citing In re Bond, 15 USPQ2d 1566 (Fed. Cir. 1990)).

✓ In this case, the cited art fails to teach or reasonably suggest a gaming machine comprising a display means and a game control means arranged to control images displayed on the display means, the game control means being arranged to play an underlying game wherein one or more random events are caused to be displayed on the display means and, if a predefined winning event occurs, the machine awards a prize, wherein on the occurrence of a predefined triggering event, the player is offered a choice of two or more different prize sets, each set containing a plurality of prize outcomes, from which prize sets a prize is to be drawn and awarded to the player, wherein the prize is drawn from the prize set or sets selected by the player and wherein the prize outcomes are independent of any prize awarded in the underlying game on the occurrence of the predefined triggering event and wherein at least one of the prize sets displays at least two different winning outcomes, as claimed.

It is also respectfully submitted that the cited art fails to teach or reasonably suggest a gaming machine comprising a display means and a game control means arranged to control images displayed on the display means, the game control means being arranged to play an underlying game wherein one or more random events are caused to be displayed on the display means and, if a predefined winning event occurs, the machine awards a prize, wherein on the occurrence of a predefined triggering event, the player is offered a choice of two or more different prize sets, each set containing a plurality of prize outcomes, one or more of the prize sets including non winning prize outcomes, and wherein including the non winning prize outcomes, each prize set has the same number of potential outcomes, from which prize sets a prize is to be drawn and awarded to the player, by a random process, the sets of prizes being presented on segments of wheels, wherein the prize is drawn from the wheel selected by the player and wherein the prize outcomes are independent of any prize awarded in the underlying

game on the occurrence of the predefined triggering event and wherein at least one of the prize sets displays two different winning outcomes, as claimed.

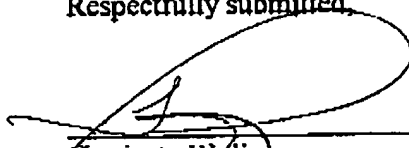
It is further respectfully submitted that the prior art fails to teach or reasonably suggest a gaming machine comprising a display means and a game control means arranged to control images displayed on the display means, the game control means being arranged to play an underlying game wherein one or more random events are caused to be displayed on the display means and, if a predefined winning event occurs, the machine awards a prize, wherein on the occurrence of a predefined triggering event, the player is offered a choice of two or more different prize sets, each set containing a plurality of prize outcomes, and wherein each prize set has the same number of potential outcomes from which prize sets a prize is to be drawn and awarded to the player, wherein the prize is drawn from the prize set or sets selected by the player and wherein the prize outcomes are independent of any prize awarded in the underlying game on the occurrence of the predefined triggering event, as claimed.

For the foregoing reasons, reconsideration is respectfully requested.

An earnest effort has been made to be fully responsive to the Examiner's objections. In view of the above amendments and remarks, it is believed that claims 1-18, consisting of independent claims 1, 14 and 17 and the claims dependent therefrom, are in condition for allowance. Passage of this case to allowance is earnestly solicited. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged on Deposit Account 50-1290.

Respectfully submitted,


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